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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,195	08/11/2006	Santiago Julian Pidevall	0070.1102	6510
21171	7590	03/16/2009		
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER WOOD, JONATHAN K	
			ART UNIT 3754	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/589,195	<b>Applicant(s)</b> JULIAN PIDEVALL ET AL.	
	<b>Examiner</b> JONATHAN WOOD	<b>Art Unit</b> 3754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/11/2006</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Double Patenting*

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1-13 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 7-19 of copending Application No. 10/589194. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

3. Claims 1-13 are directed to the same invention as that of claims 7-19 of commonly assigned Application No. 10/589194. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-2, 6-9, and 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,875,936 to *Turbett et al.* (*Turbett*).

*Turbett* shows a pump comprising a main body (121 with 118) having a first surface (surface adjacent reference numeral 117 in Figure 4), an attachment body (133 with 160) having first means for attachment to a bottle neck (142), means for attachment to a dip tube (126), an inlet valve (115), a second surface facing the first surface (underside of 118), a pumping chamber (114) defined by the two surfaces, and a discharge valve (122) at an outlet (127) of the pumping chamber. The first and second surfaces move relative to one another causing a pumping of liquid in the container (col. 5, ll. 24-29). The pump further comprises a head (118) made from an elastomeric material (col. 6, line 33) with an external actuation surface (top of 118). The discharge valve includes a valve seat (ledge of 121 above reference number 122 in Figure 7) and a moving member (122) which forms a partition that is a flat surface (Figure 7).

Regarding claims 6-9, the second surface is convexly curved as a spherical cap (Figures 5 and 6), the first surface has a concavely curved portion towards the interior of the pumping chamber and is spherical (Figures 5 and 6) and also has an external rim that is convex towards the interior of the pumping chamber (portion of second surface beneath reference numeral 116 in Figure 4). The limit of the pumping stroke is the curved portion of the first surface as that is the first point of contact for the elastomeric second surface when actuated.

Regarding claims 12-13, the pump further comprises a column (portion of head adjacent reference numeral 116 in Figure 4) proximate the discharge valve which has a height the contacts the second surface when it is in an extended position (Figure 4).

6. Claims 1-2, and 14-19 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,544,789 to *Gillingham (Gillingham)*.

*Gillingham* shows a pump comprising a main body (11) having a first surface (43), an attachment body (12) having first means for attachment to a bottle neck (col. 2, ll. 35-38), means for attachment to a dip tube (33), an inlet valve (32), a second surface facing the first surface (underside of 19), a pumping chamber (22) defined by the two surfaces, and a discharge valve (27) at an outlet (17) of the pumping chamber. The first and second surfaces move relative to one another causing a pumping of liquid in the container (col. 3, ll. 41-51). The attachment body can be relatively displaced between an open and closed position (Figures 1 and 3, respectively) and includes a projection (38) in the form of a tubular stem, which prevents the first and second surfaces from moving relative to one another. The pump further comprises a head (portion of main

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body excluding sidewalls 13 and including bellows 21) made from an elastomeric material (col. 2, line 45) with an external actuation surface (top of 19). The discharge valve includes a valve seat (side of 18 towards discharge passage 16) and a moving member (27) which forms a partition that is a flat surface (Figure 5).

Regarding claim 16, the projection is hermetically sealed against the second surface through annular projection 45 in the closed position (col. 3, ll. 55-60).

Regarding claim 17, the relative displacement of the attachment body to the main body is greater than the relative movement of the first surface to the second surface due to the added inherent vertical translation caused by the lockdown threading motion (col. 3, ll. 20-26).

Regarding claims 18 and 19, the main body has a first annular lip (18) sealing at the outer wall of the projection through bellows (21) and a second annular lip (45) forming a seal with an annular partition (portion at top of 38 which extends inwardly towards ventilation holes 44) surrounding a ventilation hole (44).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Gillingham* in view of US Patent No. 3,162,334 to *Miller*.

*Gillingham* shows all aspects of the applicant's invention as set forth in claim 1, but does disclose the movable member partition and the valve seat being cylindrical. However, *Miller* shows a pump that utilizes an annular and cylindrical dispensing passageway (66) for material to be dispensed after a discharge valve (34) but before exiting a spout (30). It would have been obvious to one having ordinary skill in the art at the time of the invention, under the teachings of *Miller*, to have made the dispensing passageway of *Gillingham* annular, thus incorporating the chamber between the wall adjacent 18 and 11 on the left side of Figure 4 as part of the dispensing passageway in order to achieve the desired dispensing characteristics. The resulting combination would yield a cylindrical valve seat and movable member, each which surround both surfaces of the pump main body.

10. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Turbett* in view of US Patent No. 6,286,697 B1 to *Gasparini* (*Gasparini*).

*Turbett* shows all aspects of the applicant's invention as set forth in claim 1, but does not disclose the valve seat having a rounded contact surface or the valve moving member having a tapered end. However, *Gasparini* shows a flap valve like that of *Turbett* in which the valve seat (44) is rounded and the moving member (19) is tapered

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(Figure 4). It would have been obvious to one having ordinary skill in the art at the time of the invention, under the teachings of *Gasparini*, to have made the moving member of the valve of *Turbett* tapered and the surface to which it seats rounded in order to enhance the reliability of the seal of the valve (*Gasparini*, col. 2, ll. 41-43).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JONATHAN WOOD whose telephone number is (571)270-7422. The examiner can normally be reached on Monday through Friday, 7:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571)272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JKW/

Examiner, Art Unit 3754

/Kevin P. Shaver/

Supervisory Patent Examiner, Art Unit 3754